

REMARKS

I. Claim Rejections under 35 USC § 102.

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Bajpai

The Examiner rejects claims 25, 30, 31 and 34 under 35 U.S.C. §102(b) as being anticipated by Bajpai (WO 97/15009). Applicants have considered Examiner's remarks. Claim 25 includes subject matter that is simply not taught by Bajpai in order for a 35 U.S.C. §102(b) rejection to be maintained. The underlined portions of claim 25 not taught by *Bajpai* are as follows:

25. A method of automating customer assistance associated with a machine, comprising the steps of:

said machine automatically recognizing a malfunction using sensors and software co-located with said machine;

said machine automatically collecting machine data including machine identification, customer identification, machine location, diagnostics/error codes, operational history and operational status, in a database associated with said machine;

said machine automatically creating a document containing said machine data;

said machine automatically transmitting said document over a data network to a remote enterprise from said machine utilizing communication equipment associated with said machine;

processing said document at said remote enterprise; and

said remote enterprise automatically proceeding with at least one of the following:

i) scheduling initiation of a telephone call by enterprise help-desk facility personnel to a customer associated with said machine to provide customer support and corrective action;

ii) transmitting corrective action over said data network directly to said machine;

iii) escalating said fault analysis to an advanced customer support unit within said remote enterprise.

Bajpai does not teach or suggest the entire method wherein a machine: automatically recognizes a malfunction using sensors and software co-located with said machine; automatically collects machine data including machine identification, customer identification, machine location, diagnostics/error codes,

operational history and operational status, in a database associated with the machine; automatically creates a document containing the machine data.... Examiner cites to page 10, lines 3-9 in Bajpai for teaching automatic collection of machine location and operational history. This is not found in the passage cited by Examiner:

- Where the local digital data processor runs under MircoSoft Windows 95™, the information passed to the remote diagnostic element 50 includes the files: SYSTEM.INI,
- 5 WIN.INI, the Registry, AUTOEXEC.BAT and CONFIG.SYS. It also includes user identification information, hardware identification information, I/O address information, and IRQ Information. It also includes information gathered by the local diagnostic element (e.g., directly from the user or via the instrumentation) regarding the symptoms and characteristics of the specific problem to be solved.

Furthermore, Bajpai does not teach the use of "sensors" on page 5, lines 9-11 wherein a "diagnosotic element 28" is described:

- In still other aspects, the local and remote diagnostic elements are capable of reconfiguring
- 10 the digital data processor to correct identified problems. This can include, for example, altering configuration files or upgrading software (such as Window™ drivers). Again, whereas the local diagnostic element can make those corrections directly to the digital data processor, the remote diagnostic element makes them remotely, e.g., via modem. The technical support interface likewise permits the human operator to apply corrective measures, e.g., via modem, and to
- 15 directly control the digital data processor, e.g., using remote control software.

The "diagnostic element" is clearly nothing more than a microprocessor running software to reconfigure the data processor associated with the system described therein. Applicant's invention uses software too, but it also uses physical sensors as clearly written in claim 25.

Bajpai only clearly teaches the use of software tools, not sensors, and Bajpai does not determine a machine's location and operational history. Therefore, Bajpai does not disclose each and every limitation of the Applicant's remaining independent claims 25. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(b) rejection of claim 25 based on the Bajpai reference be withdrawn. Claims 30, 31 and 34 ultimately depend on claim 25, and are therefore not anticipated by *Bajpai* also. For these reasons the rejection is respectfully traversed.

II. Claim Rejections - 35 USC § 103.

Bajpai in view of Sese et al.

The Examiner rejects claims 36, and 38-43 under 35 U.S.C. §103(a) as being unpatentable over Bajpai in view of Sese et al. (U.S. Pub. No. 2005/0097405), hereinafter referred to as "Sese".

The argument provided above with respect to anticipation by *Bajpai* is incorporated herein. Regarding claim 36, the combination of *Bajpai* with *Sese* still does not teach all of these elements claimed by Applicant (e.g., sensors and automatic retrieval of machine location and usage history). Adding a "photocopier" by using the Sese reference still does not result in a complete teaching, or suggestion, of Applicant's invention. Applicant's claim 36 provides as follows:

36. (Previously amended) A method of automating customer assistance associated with a photocopying machine, comprising the steps of:

 said photocopying machine automatically recognizing a malfunction using sensors and software co-located with said machine;

 said photocopying machine automatically collecting machine data including machine identification, customer identification, machine location,

diagnostics/error codes, **operational history** and operational status, in a database associated with said photocopying machine;

said photocopying machine automatically creating a document containing said machine data;

said photocopying machine automatically transmitting said document over a data network to a remote enterprise from said machine utilizing communication equipment associated with said photocopying machine; and

said remote enterprise automatically proceeding with at least one of the following:

i) scheduling initiation of a telephone call by enterprise help-desk facility personnel to the customer identified as associated with said photocopying machine to provide customer support and corrective action;

ii) transmitting corrective action over said data network directly to said photocopying machine;

iii) escalating said fault analysis to an advanced customer support unit within said remote enterprise.

In particular, the combination of *Bajpai* with *Sesek* does not teach: a machine automatically recognizing a malfunction using sensors and software co-located with said machine; automatically collecting machine data including machine identification, customer identification, machine location, diagnostics/error codes, operational history and operational status, in a database associated with the machine; automatically creating a document containing the machine data; automatically transmits the document over a data network to a remote enterprise from said machine utilizing communication equipment associated with said machine; and remote enterprise automatically proceeding with at least one of i) scheduling initiation of a telephone call by enterprise help-desk facility personnel to the customer identified as associated with said machine to provide customer support and corrective action, ii) transmitting

corrective action over said data network directly to said machine, iii) escalating said fault analysis to an advanced customer support unit within said remote enterprise.

The Examiner has not shown that the references, singularly or in combination, disclose each and every limitation of the Applicant's claims 36. The Examiner has not shown a reasonable expectation of success of combining the references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 36 and 38-43, based on the Bajpai and Pfeiffer references, be withdrawn

Bajpai in view of Pfeiffer et al.

The Examiner rejects claims 35 under 35 U.S.C. §103(a) as being unpatentable over Bajpai in view of Pfeiffer et al. (U.S. Pub. No. 2004/0078722), hereinafter referred to as "Pfeiffer".

The argument provided above with respect to anticipation by *Bajpai* is incorporated herein. Claim 35 is dependent on claim 25 for which is has been argued that *Bajpai* does not teach all of these elements claimed by Applicant (e.g., sensors and automatic retrieval of machine location and usage history). For this reason, Claim 35 is not obvious and the rejection is respectfully traversed.

Bajpai in view of Sese et al., further in view of Pfeiffer et al.

The Examiner rejects claims 44 under 35 U.S.C. §103(a) as being unpatentable over *Bajpai* in view of *Sese et al.*, and further in view of *Pfeiffer et al.*

The argument provided above with respect to obviousness of claim 36 by *Bajpai* in view of *Sese* is incorporated herein. Claim 44 is ultimately dependent on claim 36 for which it has been argued that *Bajpai* in view of *Sese* does not teach or suggest all of these elements claimed by Applicant (e.g., sensors and automatic

retrieval of machine location and usage history). For this reason, Claim 44 is not obvious and the rejection is respectfully traversed.

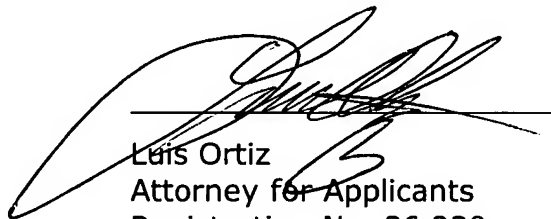
III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests withdrawal of the objections and rejections under 35 U.S.C. §102, 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

The Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application should there be any outstanding matters that need to be resolved.

Respectfully submitted,

Dated: April 8, 2008

A handwritten signature in black ink, appearing to read 'Luis Ortiz', is written over a horizontal line.

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